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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,174	04/19/2004	Masayuki Yoshida	H 50019	2416

423 7590 07/22/2005

HENKEL CORPORATION
THE TRIAD, SUITE 200
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EXAMINER

TUROC, DAVID P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,174

Applicant(s)

YOSHIDA ET AL.

Examiner

David Turocy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The applicant's amendments, filed 6/21/2005, have been fully considered and reviewed by the examiner. The examiner notes the submission of new correct drawings and therefore the objection to the drawings has been withdrawn. In light of the amendments to claims 1 and 13 the examiner has withdrawn the claim objections. The examiner notes the addition of the new claim 21. Claims 1-21 are currently pending.

Response to Arguments

2. Applicant's arguments filed 6/21/2005 have been fully considered but they are not persuasive.

The applicant has argued against the Imai reference stating they teach of a lubricant where a synthetic resin is used as the main component and also argues Imai does not teach of a continuous inline system. However the examiner respectfully disagrees. While synthetic resin may be the main component of the lubricant as taught by Imai, the claim does not limit the lubricant bath to only the components listed. In addition the examiner notes, Page 12, lines 25-28 of Imai, they disclose the lubricant composition can be used during cold plastic working, such as wire drawing and pipe drawing, which are known in the art as continuous processes, where the steps as taught by Imai would all be utilized in a continuous inline system.

The applicant has argues against the Imai reference stating they teach of cleaning and a lubrication times larger then the claimed times and there is no teaching

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in the Imai reference to shorten either times. While the examiner agrees the times as taught by Imai reference are longer than the claimed times, the examiner maintains the position that such times are known result effective variables as discussed in the office action dated 12/21/2004. It is the examiner position that it is well within the skill of one of ordinary skill in the art to optimize the cleaning and lubrication time depending on the desired properties associated with such cleaning and lubrication times.

The applicant has argued against the Hagita reference stating they use a zinc phosphate conversion coating during the continuous in-line drawing process and a lubricant with a reactive soap. The applicant has argued Hagita does not properly teach of lubrication times as taught by the applicant's claims. While the examiner agrees Hagita teaches of a zinc phosphate coating, Imai teaches such a undercoat is not requires using the lubricant composition. Therefore, the examiner is only utilizing Hagita to show the process of applying a lubricant is known in the art to be a cause effective variable depending on various factors and therefore optimization of such lubrication times is well within the skill of one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3-5, 8, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/64544 by Imai et al ("Imai").

Claims 1, 3-5, 8, and 11 are rejected for the same reasons as set forth in the office action date 12/21/2004 and for the reasons in section 2 above.

6. Claims 1-6, 8-11, 13-14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/64544 by Imai et al ("Imai") in view of US Patent 4688411 by Hagita et al ("Hagita").

Claims 1-6, 8-11, 13-14, and 16-20 are rejected for the same reasons as set forth in the office action date 12/21/2004 and for the reasons in section 2 above.

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7. Claims 7, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/64544 by Imai et al ("Imai") taken in view of US Patent 4688411 by Hagita et al ("Hagita") alone or when further taken in view of US Patent 5282377 by Illig et al ("Illig").

Claims 7, 12, and 15 are rejected for the same reasons as set forth in the office action date 12/21/2004 and for the reasons in section 2 above.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3931020 by Burgess et al. in view of WO 99/64544 by Imai et al ("Imai").

Burgess teaches of an aqueous lubricant for use in lubricating metal during forging or other similar metal operation (Column 1, lines 14-16). Burgess discloses using an aqueous lubricating coating composition consisting of at least one inorganic salt and a graphite lubricant (abstract). Burgess discloses an inorganic salt to lubricant ratio within the ratio as claimed (Table II).

Burgess fails to disclose using the lubricant during the manufacturing of metal wire rod by first cleaning the wire for 20 seconds or less, second preheating the wire and contacting the wire with the lubricant, and finally drying the film on the wire rod.

However, Imai is applied here as applied to claim 1 above, in addition Imai also teaches of using a similar aqueous lubricants during various metal working processes such as wire drawing, pipe drawing, forging (Page 12, lines 25-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Burgess to use the aqueous lubricant during a continuous wire drawing process as suggested by Imai to provide a desirable lubrication for the metal because Burgess discloses using the lubricant solution during a forging process or any other known metal process and Imai discloses wire drawing and pipe are known in the art to, like forging processes, require an aqueous lubricant and therefore would reasonably be expected to effectively provide lubrication during the wire drawing process.

Burgess in view of Imai fails to specifically teach cleaning the wire rod for 20 seconds or less. However, it is the examiners position that it is within the skill of one of ordinary skill in the art to determine the optimum value for a cleaning process. Fast enough for the process to produce an acceptable amount of cleanness in order to produce usable product, but not too slow as to cause an economic loss due to over cleaning. One of ordinary skill in the art at the time of the invention would recognize cleaning of metal prior to lubrication in cold plastic working requires a small amount of time. Therefore, it would have been obvious to one having ordinary skill in the art to have determined the optimum time of cleaning through routine experimentation. See *In re Aller*, USPQ 233 (CCPA 1955).

Burgess in view of Imai also fails to suggest contacting the metal wire with a lubricant for 5 seconds or less. However, Imai discloses a lubricant composition that prefers a simple application process consisting of immersion or spraying (Column 2,

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lines 57-60). While the examiner acknowledges that the examples of Imai show an immersion time of Imai of 30 seconds, these showings are merely exemplary and are not limiting. It is the examiners position that it is within the skill of one of ordinary skill in the art to determine the suitable lubrication time to properly coat a metal in cold plastic working to provide sufficient lubrication for the process. Therefore, it would have been obvious to one having ordinary skill in the art to have determined the optimum lubrication time through routine experimentation in the absence of a showing of criticality. See *In re Aller*, USPQ 233 (CCPA 1955).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

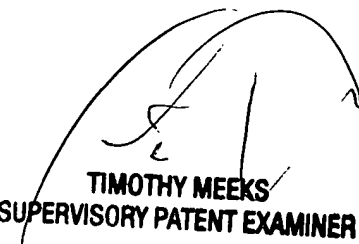
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy
AU 1762



TIMOTHY MEES
SUPERVISORY PATENT EXAMINER